



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,110	10/15/2001	Menno Heringa	01-48 US	3739
23693	7590	10/31/2003	EXAMINER	
Varian Inc. Legal Department 3120 Hansen Way D-102 Palo Alto, CA 94304			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/978,110	Applicant(s) HERINGA ET AL.	
	Examiner Krishnan S Menon	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-18 and 21-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11-13, 17, 18 and 21-30 is/are allowed.
- 6) ☐ Claim(s) 14-16 and 31-37 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-9, 11-18, and 21-37 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Netherlands on 10/13/00. It is noted, however, that applicant has not filed a certified copy of the Foreign application as required by 35 U.S.C. 119(b).

Allowable Subject Matter

Claims 1-9, 11-13, 17,18 and 21 – 30 are allowed.

The following is an examiner's statement of reasons for allowable subject matter: The instant claims recite the element 'strip/carrier/handle ... extending along a plane of the ... ring...', which is not taught by the prior art Rounbehler et al(US 5,808,178), and is not obvious from the prior art because this carrier/strip would obstruct the fan that runs in the radial plane at the top-center of the spiral column of the prior art Rounbehler.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14 and 32-37 is rejected under 35 U.S.C. 102(b) as being anticipated by Rounbehler et al(US 5,808,178).

Rounbehler (178) teaches a strip form (120) with slots 135 (fig 3) on a major surface forming “clips” to hold ends of the chromatographic column as in instant claim 14. Please note that ‘a major surface’ is not clearly defined, and can be any surface, and that ‘for connecting to a chromatographic column’ is intended use [A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)]

Rounbehler also teaches chromatographic column connector (105) as in claim 32; a pair of connecting parts (125) positioned at opposite ends connecting the handle (120) to the winding structure (the whole assembly of fig 2 and 3 forming a winding structure) as in claim 33; connecting parts have apertures as in claim 34 (145); fluidically coupling two columns as in claim 35 (see fig 25); connecting parts (125), column connector (105) protruding from a major surface, and clips formed along the major surface (slots perpendicular to the surface) holding the column ends as in claim 36; the connecting parts comprising aperture extending through the strip handle as in claim 37 (see hole 145).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rounbehler (178) in view of Haas et al (US 6,454,939).

Rounbehler (178) teaches a strip form part for use with a winding structure of a chromatographic column as in instant claim 15 and 16, but is silent on displaying information as in instant claim 15 and the strip part containing indicia as in instant claim 16.

Haas (939) teaches such a strip with display information and measurement indicia and/or stencil for marking/measuring the TLC plates, for a thin-layer chromatographic system (see fig 2 and col 2 lines 40-45). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Haas (939) and provide display information and measurement indicia on the strip form parts of Rounbehler (178) for measuring insertion depth or column length like what is taught by Haas (939).

2. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rounbehler (178).

The strip form handle comprises a pair of clips at opposite ends (slots at the ends), but they are not opposite-facing. However, it would be obvious to one of ordinary skill in the art at the time of invention that the opposite-facing clips are equivalent to the prior art element: the prior art element performs the identical function specified in the claim in substantially the same way, and

produces substantially the same results as the corresponding element disclosed in the specification.

Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)

Response to Arguments

Applicant's arguments filed on 9/22/03 have been fully considered but they are not persuasive with regard to the rejected claims. Argument re claim 14 is that the slot is not on a major surface. However, there is no clear definition of what would be a major surface, and even if the applicant were to define the major surface, the slot would still be equivalent to the clip performing identical function [*Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)]. Argument re claim 35 is that it recites a connector for coupling two columns, which is addressed in the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Application/Control Number: 09/978,110
Art Unit: 1723


Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner


JOSEPH D. DODGE
PRIMARY EXAMINER